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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,553	08/09/2001	Michael G. Dykhoff	56950US002	5531

7590 02/24/2003

Attention: David B. Patchett  
Office of Intellectual Property Counsel  
3M Innovative Properties Company  
P.O. Box 33427  
St. Paul, MN 55133-3427

EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 02/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/925,553

Applicant(s)

DYKHOFF, MICHAEL G.

Examiner

Jane J Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. Newly submitted claim 14 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: New submitted claim 14 directed to a method.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 14 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6-7 are rejected under 35 U.S.C. 102(b) as being unpatentable by Wilson (5502937).

Wilson discloses a composite fire stop article comprising an interior insulating material (figure 6 number 28) and an intumescent material (figure 6 number 29) arranged around at least a portion of the interior material (figure 6 number 29 and 28), the intumescent material consisting essentially of filler material, binder material, and a hydrated alkali metal silicate intumescent

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component (col. 6 lines 45-50). Wilson discloses that the intumescent material further includes organic char-forming components (col. 6 line 49). Wilson discloses that the interior insulating material comprises inorganic fibrous material (col. 8 line 24). Wilson discloses that the inorganic fibrous material comprises at least one of fiberglass, mineral wool, refractory ceramic materials, and mixtures thereof (col. 3 lines 31-35). Wilson discloses that the interior insulating material has opposed first and second opposed major surfaces, and further wherein the sheets of intumescent material are arranged adjacent each of the first and second surfaces (figure 6 number 29 and 28). Wilson discloses that the intumescent sheets is adhesively bonded with the insulating material first and second major surfaces (col. 4 lines 1-3). Wilson discloses that the intumescent sheets bond to the insulating material upon exposure to a temperature of 1200°F (col. 5 line 25-26).

As to the fire stop article being used to fire stop an opening in a partition, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 2d 1647 (1987).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to

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be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson in view of Eiermann (4584214).

Wilson discloses that the inorganic fibrous material comprises 50% mineral wool (col. 7 lines 15-16). Wilson fails to disclose that the mineral wool has a density of at least 4 pounds per cubic foot. Eiermann discloses that the mineral wool has a density of at least 4 pounds per cubic foot (col. 4 lines 55-57) for the purpose of preventing heat penetration for a sufficiently long time (col. 4 lines 66-68).

Therefore, it would have been obvious to one of ordinary skill in the art to have provided Wilson with mineral wool that has a density of at least 4 pounds per cubic foot in order to prevent heat penetration for a sufficiently long time (col. 4 lines 66-68) as taught by Eiermann.

4. Claims 9-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson in view of Sakno (5634304).

Wilson discloses the fire stop article described above. Wilson fails to disclose that the fire stop article further comprises a polyethylene enclosure arranged around the intumescent material. Sakno teaches a polyethylene enclosure arranged around the intumescent material for the purpose of containing the expansion of the intumescent material and focus its expansion on

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collapsing the conduit without reliance upon containment by surrounding concrete (col. 3 lines 1-4).

Therefore, it would have been obvious to one of ordinary skill in the art to have provided Wilson with a polyethylene enclosure arranged around the intumescent material in order to contain the expansion of the intumescent material and focus its expansion on collapsing the conduit without reliance upon containment by surrounding concrete (col. 3 lines 1-4) as taught by Sakno.

### ***Response to Arguments***

5. Applicant's arguments filed 11/27/02 have been fully considered but they are not persuasive.

In response to applicant's argument that a plurality of the fire stop articles can be used to create a fire stop in an opening having an area of greater than 300 square inches and a concrete substrate for adhesion capable of passing a hose stream test in accordance with ASTM Test E814 without secondary reinforcement, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.

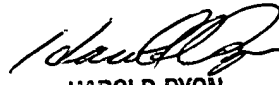
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jane Rhee  
February 13, 2003



HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

2/21/03